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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,710	12/01/2000	Volker Schreiner	Beiersdorf 688-VMM	7950

7590

10/09/2002

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EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,710

Applicant(s)

SANDHOFF ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-12 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-12 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of the amendment filed March 18, 2002 and the response to Notice of Non-compliant amendment filed July 26, 2002. Claims 5-12 have been amended. Claims 13-25 have been canceled. Claims 5-12 and 26 are pending.

Information Disclosure Statement

The information disclosure statement filed March 12, 2001 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the copies of the documents listed provided by Applicant are not legible. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Applicant appears to have misunderstood the objection to the information disclosure statement. Firstly, it is noted that the objection was directed to the information disclosure statement that was filed on March 12, 2001, not the one filed concurrently with the application on December 01, 2000. A copy of the information disclosure statement filed December 01, 2000 should have been mailed initialed and signed to indicate that the references had been considered at the time of the last Office Action. If Applicant did not receive an initialed and signed copy of the information

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disclosure statement that was filed December 01, 2000, Applicant is invited to telephone the Examiner for a faxed copy. However, the references filed March 12, 2001, which are not contained in the USPTO's in-house databases, are not legible. The Examiner is unable to read these references and is, therefore, unable to consider their relevance to the instant invention.

Specification

The objections to the specification are withdrawn upon consideration of Applicants' remarks and further review of the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is maintained for reasons of record in the Office Action mailed December 20, 2001, paper no. 6. The specification does not provide a written description of strengthening the lipid barrier or increasing the synthesis rates of ceramides of human skin by application of the claimed composition.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 is indefinite because it depends from canceled claim 13. The metes and bounds of the claim cannot be determined.

Claims 5-11 were rejected under 35 U.S.C. 112, 2nd paragraph as being indefinite because of problems with idiomatic English. It appears that Applicants misspelled the word effectively. Based on the amendment of "effect" to "effectively" this rejection is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 5-12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over PI 9303217-0 A (217), which is the same as PI 9303217, based on the English language translation provided herein. See the English language translation for all citations.

PI '217 is directed to extracting flavanoids from tea leaves for use in cosmetics (page 1-4). The flavanoids extracted from the tea leaves include catechin, epicatechin, epigallocatechin and gallocatechin, *inter alia*. For the catechin that corresponds to the formula of claim 7, see formula EC at page 3. PI '217 discloses at page 4, paragraph 2 that the tea *Camellia sinensis* is a commonly used source for these catechins. The catechins provide various benefits such as skin-softening, skin-moisturizing and emolliency (page 6, paragraphs 4 and 5 and page 7, last paragraph). For topical cosmetic compositions containing 0.1-1.0 wt% catechins see page 8, last paragraph.

PI '217 does not explicitly disclose application of the compositions containing the catechins to the skin. PI '217 does disclose that the compositions can be provided as cosmetic product for providing moisture conservation and emolliency to skin. One of ordinary skill in the art would expect from this disclosure to obtain skin moisturization and emolliency by applying these compositions to dry skin.

The claims are directed to a method of applying a composition to the skin of a human. The intended purpose or expected result of application of the composition to the skin does not render the claims patentable over the prior art. Terms merely setting forth an intended use for, or a property inherent in, an otherwise old composition do not differentiate the claimed composition from those of the prior art. *In re Pearson*, 181

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USPQ 641. Difference in use cannot render claimed composition novel. *In re Tuominen*, 213 USPQ 89. The prior art teaches cosmetic compositions containing the instantly claimed components for use as moisturizers for the skin. One of ordinary skill in the art would expect compositions containing the same components to exhibit the same properties, i.e. moisturization, absent evidence to the contrary.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the compositions of PI '217 to dry skin expecting to provide moisturization and emolliency.

Response to Arguments

Applicant's arguments with respect to the art rejections of claims 5-12 and 26 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed March 18, 2001 with respect to the 35 U.S.C. 112, 1st paragraph rejection have been fully considered but they are not persuasive.

Applicant argues that the Examiner did not provide reasons or an explanation of why it is believed that Applicants have not adequately described their invention. As reiterated above, the Examiner stated that the specification did not provide a written description of strengthening the lipid barrier or increasing the synthesis rates of ceramides of human skin by application of the composition to the skin. After a fair review of the specification, the Examiner was unable to find any mention of strengthening the lipid barrier or increasing the synthesis rates of ceramides of human skin. There was simply no written description of this provided at all.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysa Berman
Patent Examiner
October 3, 2002


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